

REMARKS

Claims 2-6 and 16-19 are pending in the application. The Examiner has allowed claims 16-19. Paper No. 12, page 3. The Examiner has further objected to claims 4-6 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Paper No. 12, page 3. The Examiner maintains his rejection of claim 1 under 35 U.S.C. §102(e). Paper No. 12, page 4. Applicants have amended claim 4 to be written in independent form including all of the limitations of the base claim and any intervening claims and hence claims 4-6 are allowable.

Applicants note that claim 4 was not amended to overcome prior art but to be written in independent form. Hence, the amendment made to claim 4 was not narrowing in scope and therefore no prosecution history estoppel arises from the amendment to claim 4. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 62 U.S.P.Q.2d 1705, 1711-12 (2002); 56 U.S.P.Q.2d 1865, 1870 (Fed. Cir. 2000). Further, the amendment made to claim 4 was not made for a substantial reason related to patentability and therefore no prosecution history estoppel arises from such an amendment. *See Festo Corp.*, 62 U.S.P.Q.2d 1705 at 1707 (2002); *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 41 U.S.P.Q.2d 1865, 1873 (1997).

Applicants further note that Applicants have adopted the Examiner's suggestion in the Examiner's Answer (Paper No. 12, page 3). The Examiner states that "claims 4-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims." Paper No. 12, page 3. Applicants have amended claim 4 incorporating the limitations of claim 2 and therefore adopt Examiner's suggestion. Consequently, claims 4-6 are allowable. According to M.P.E.P. §1207, amendments may be entered upon filing of an appeal brief provided that the amendment conforms to the requirements of 37 C.F.R. §1.116. According to 37 C.F.R. §1.116, amendments may be made complying with any requirements of form expressly set forth in a previous Office Action. Applicants adopt the Examiner's

suggestion as set out in Paper No. 12, which requires only a cursory review by the Examiner and therefore satisfies the requirements of 37 C.F.R. §1.116. M.P.E.P. §1207. Furthermore, a showing of good and sufficient reasons as to why the amendment is necessary and not presented earlier is not required because Applicants adopt Examiner's suggestion as set out in Paper No. 12, which requires only a cursory review by the Examiner. M.P.E.P. §1207. Nevertheless, Applicants note that this is Applicants' first opportunity to amend claim 4 to be written in independent form including all of the limitations of the base claim and any intervening claims. Claim 4 was previously rejected under 35 U.S.C. §103(a) as of the date that Applicants filed their Appeal Brief. In response to Applicants filing their Appeal Brief, the Examiner newly objected to claim 4 in the Examiner's Answer. Applicants respectfully assert that this establishes good and sufficient reasons under 37 C.F.R. §1.116. Therefore, Applicants kindly request the Examiner to enter the amendment to claim 4 resulting in the allowance of claims 4-6.

CONCLUSION

Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

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